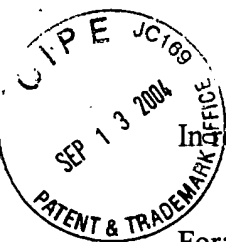


15w)  
\$

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of  
*Dabney et al.*

) Examiner: R. S. Rollins

) Group Art Unit: 3739

For: **HIGH FREQUENCY POWER SOURCE**

Serial No.: 10/658,572

Filed: September 9, 2003

) **TRANSMITTAL**

Atty. Docket No.: R0367-01901

**CERTIFICATE OF MAILING PURSUANT TO 37 CFR 1.8**

I hereby certify that this paper is being deposited in the United States mail as first class mail with postage prepaid, and is addressed to Mail Stop  
Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 9/10/04 in San Francisco, CA.

By

*Anne Marie Leavy*  
Anne Marie Leavy

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

1. Transmitted herewith for filing in the above-identified patent application is a Request for Reconsideration of Decision on Petition Mailed March 24, 2004.

2. Claim Fee Calculation

- ☒ No additional claim fee is required.  
☐ Amendment increases number of claims or multiple dependencies.

**Additional Claim Fee Calculation**

Description	Fee Code	Claims	Extra	Rate	Fee
Independent Claims	2201	2 - 3 =	0 x	\$43=	\$-0-
Total Claims	2202	38 - 20 =	0 x	\$9=	\$-0-

**Total Fees Due .....\$-0-**

3. Additional fees: Request for Extension of Time for three (3) months from June 24, 2004 to September 24, 2004 pursuant to 37 CFR §1.17(a)(3), (Fee Code 2253).....**\$475.00**

4. Payment of Fees

- Enclosed is a check for the total fees due in the amount of \_\_\_\_\_.  
☒ The Commissioner is authorized to charge any additional fees and to credit any overpayment of fees which may be required under 37 C.F.R. §1.16 or §1.17, to Deposit Account No 04-1679, referencing Atty. Docket No. R0367-01901.

By

*Edward J. Lynch*  
Edward J. Lynch  
Registration No. 24,422

Duane Morris LLP  
One Market  
Spear Tower, Suite 2000  
San Francisco, CA 94105  
**Direct Dial: (415) 371-2267**  
Facsimile: (415) 371-2201

09/15/2004 WABDELRI 00000021 041679 10658572

01 FC:2253 475.00 DA



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of  
Dabney et al.

) Examiner: R. S. Rollins

) Group: 3739

For: **HIGH FREQUENCY POWER SOURCE**

Serial No.: 10/658,572

Filed: September 9, 2003

Atty. Docket No.: R0367-01901

**CERTIFICATE OF MAILING PURSUANT TO 37 CFR 1.8**

I hereby certify that this paper is being deposited in the United States mail as first class mail with postage prepaid, and is addressed to Office of Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 9/10/04 in San Francisco, CA.

By: [Signature]

**REQUEST FOR RECONSIDERATION OF DECISION ON PETITION**

**MAILED MARCH 24, 2004**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request reconsideration of the Patent Office decision (Office of Petitions) mailed on March 24, 2004, regarding Applicants Petition re missing drawings in the above-referenced application. Applicants' Petition was dismissed by the Petition Attorney based on review of the application file and finding thirty-three (33) sheets of drawings and no drawing figures labeled 13 or 14 included among the drawings.

The Petition Attorney dismissed the applicants Petition on the grounds that the "petition papers filed on January 22, 2004 did not include a copy of the Patent Office date-stamped postcard, although petitioner indicated that such evidence would be provided". However, Petitioner provided a copy of the date-stamped postcard with the original petition indicating that 36 sheets of drawings had been received by the Office. A copy of the petition papers as filed on

January 22, 2004 in their entirety is attached as Exhibit A. As shown, a copy of the Patent Office date stamped return receipt postcard of the Request for Filing A Divisional as filed on September 9, 2003 was included in the petition papers. As further evidence of Applicants' submission of the Patent Office date-stamped return receipt postcard with the Petition, also enclosed herein as Exhibit B is a copy of the Patent Office date-stamped return receipt postcard that was received from the Office reflecting that in the filing of the Petition, a copy of the return receipt postcard for the filing of September 9, 2003 was included therein.

In the return receipt postcard for the application filing on September 9, 2003, the Office acknowledged receipt of 36 sheets of formal drawings and did not indicate anything to the contrary. In Applicants' records, Figures 13 and 14 are found in drawing sheets 35/36 and 36/36 respectively.

Applicants have submitted the date-stamped return receipt postcard as evidence that the Office received all thirty six sheets of drawings with the application as filed. The instructions for Petitions found in the Patent Office website, (copy enclosed) clearly state in paragraph 5a(6) on page 8, that

The best evidence of what the Office received is a properly itemized postcard receipt stamped with the mail room date.

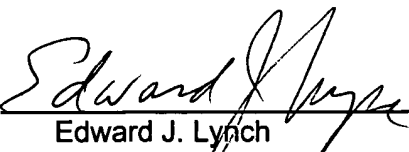
Applicants have submitted the postcard which has been date-stamped by the Office with the mail room date indicating that 36 pages of drawings were received. Petitioner has attached hereto in Exhibit A and hereby resubmits the date-stamped postcard along with the original Petition. This submission should be determinative. Moreover, the evidence that Petitioner did in fact submit this date-stamped postcard with the Petition is found in the date-stamped postcard receipt returned from the Office (Exhibit B) indicating that the date-stamped postcard was received by the Office along with the Petition papers.

Concurrently herewith, Applicants have submitted copies of the previously submitted drawing pages 35 and 36 containing Figures 13 and 14 with Applicants response to the restriction requirement.

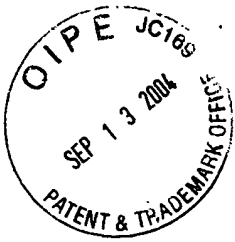
Applicants respectfully request reconsideration of the previously submitted Petition. The Patent Office, in the return receipt postcards, acknowledged receipt of a total 36 sheets of formal drawings on September 9, 2003 and the Patent Office again acknowledged receipt of a copy of that postcard of September 9, 2003 in applicants filed Petition of January 22, 2004. There was no indication otherwise by the Patent Office in either occasions other than in the Office's decision on the Petition.

Based on the facts presented above and the attached copies of the postcard receipts, Applicants believe themselves not to be in error of omitting formal drawings of Figures 13, 14 nor failing to provide the Patent Office with copies of the relevant return receipt postcards of the Patent Office receipt filing of September 9, 2003 and January 22, 2004. The Petition fee under 37 CFR §1.17(h) is not enclosed herewith; however, should the Commissioner find Applicants to be in error, the Commissioner is hereby authorized to charge any fees due and to credit any overpayment of fees which may be required under 37 CFR §§1.16 and 1.17 to Deposit Account No. 04-1679, referencing Atty. Docket No. R0367-01901. A petition for three month extension is requested in the attached Transmittal.

Respectfully submitted,

By:   
Edward J. Lynch  
Registration No. 24,422  
Attorney for Applicants

DUANE MORRIS LLP  
One Market, Spear Tower, Ste. 2000  
San Francisco, CA 94105  
Telephone: (415) 371-2200  
Facsimile: (415) 371-2201  
Direct Dial: (415) 371-2267



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COMMISSIONER FOR PATENTS  
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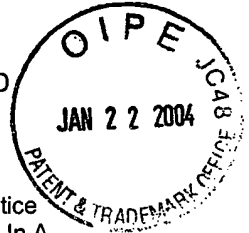
Atty Docket No. / Atty / Asst: R0367-01901 / EJL / RD

Serial No.: 10/658,572

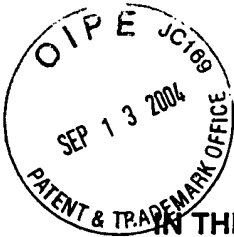
Filed: September 9, 2003

**Documents:**

Transmittal in duplicate; Petition For Reconsideration Of Notice Of Omitted items; Response to Notice Of Omitted Item(s) In A Nonprovisional application; Part 2-Notice Of Omitted Item(s) In A Nonprovisional Application-Filed Under 37 CFR 1.53(b); 2 sheets of formal drawings (sheet # 35/36 and 36/36) bearing Figs. 13, 14; copy of returned receipt postcard from Patent Office; and self-stamped return receipt postcard.



**CERTIFICATE OF MAILING PURSUANT TO 37 CFR 1.8**  
Mailed in San Francisco, CA on January 20, 2004



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of  
Dabney et al.

) Examiner: Not yet assigned

) Group Art Unit: 3739

For: **HIGH FREQUENCY POWER SOURCE**

Serial No.: 10/658,572

Filed: September 9, 2003

TRANSMITTAL

Atty. Docket No.: R0367-01901

CERTIFICATE OF MAILING PURSUANT TO 37 CFR 1.8

I hereby certify that this paper is being deposited in the United States mail as first class mail with postage prepaid, and is addressed to Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 1/20/2004 in San Francisco, CA.

By: 

Mail Stop MISSING PARTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

1. Transmitted herewith for filing in the above-identified patent application are

- X Petition For Reconsideration Of Notice Of Omitted Items;
- X Response To Notice Of Omitted Item(s) In A Nonprovisional Application;
- X Part 2 - Notice Of Omitted Item(s) In A Nonprovisional Application – Filed Under 37 CFR 1.53(b);
- X Two sheets of formal drawings (35/36 and 36/36) bearing Figs. 13, 14;
- X Copy of returned receipt postcard acknowledgement from Patent Office; and
- X Self-stamped return receipt postcard.

2. Fees Due

- X Petition fee per 37 CFR §1.182(h), \$130.

3. Payment of Fees

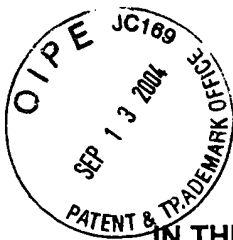
- X The Commissioner is authorized to charge any fees and to credit any overpayment of fees which may be required under 37 C.F.R. §1.16 or §1.17, to Deposit Account No 04-1679, referencing Atty. Docket No. R0367-01901. A duplicate copy of this sheet is enclosed for this purpose.

Respectfully submitted,

By: 

Edward J. Lynch  
Registration No. 24,422  
Attorney for Applicants

Duane Morris LLP  
One Market, Spear Tower, Suite 2000  
San Francisco, CA 94105  
Telephone: (415) 371-2200  
Facsimile: (415) 371-2201  
Direct Dial: (415) 371-2267



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of  
Dabney et al.

For: **HIGH FREQUENCY POWER SOURCE**

Serial No.: 10/658,572

Filed: September 9, 2003

Atty. Docket No.: R0367-01901

) Examiner: Not yet assigned

) Group: 3739

) **PETITION FOR**  
) **RECONSIDERATION OF NOTICE**  
) **OF OMITTED ITEMS**

**CERTIFICATE OF MAILING PURSUANT TO 37 CFR 1.8**

I hereby certify that this paper is being deposited in the United States mail as first class mail with postage prepaid, and is addressed to Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 1/20/2004 in San Francisco, CA.

By: *[Signature]*

Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

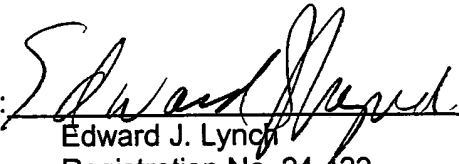
Applicants have received the Notice of Omitted Item(s) In A Nonprovisional Application, mailed December 4, 2003 and having a response due February 4, 2004 in the above-identified application. The Notice of Omitted Item(s) states that Figure(s) **13, 14** described in the specification appear to have been omitted from the application upon filing.

Applicants hereby petition the Patent Office for reconsideration of the Notice of Omitted Item(s) in the above-identified application filed on September 9, 2003. Based upon the evidence in our file, this application was expressed mailed to the Patent Office on September 9, 2003 in its entirety along with a Request For Filing A Divisional Application Under 37 CFR §1.53(b). A complete copy of the copending prior application Serial No. 09/752,978 as filed December 28, 2000, including the signed Declaration And Power Of Attorney, with 36 sheets of formal drawings in lieu of the informal drawings originally filed. A copy of the returned receipt postcard from the Patent Office as acknowledgment of having received everything listed and

detailed on the postcard is enclosed herewith. The Patent Office acknowledged receiving 36 sheets of formal drawings. Figures 13, 14 in the above-identified application were submitted respectively to the Patent Office as sheets 35/36 and 36/36.

Based on the facts presented above, Applicants believe themselves not to be in error of omitting formal drawings of Figures 13, 14. The Petition fee under 37 CFR §1.17(h) is not enclosed herewith; however, should the Commissioner find Applicants to be in error, the Commissioner is hereby authorized to charge any fees due and to credit any overpayment of fees which may be required under 37 CFR §§1.16 and 1.17 to Deposit Account No. 04-1679, referencing Atty. Docket No. R0367-01901. Applicants respectfully submit that Figures 13,14 in the above-identified application were indeed included with the application at the time of filing and respectfully request reconsideration.

Respectfully submitted,

By:   
Edward J. Lynch  
Registration No. 24,422  
Attorney for Applicants

DUANE MORRIS LLP  
One Market  
Spear Tower, Ste. 2000  
San Francisco, CA 94105  
Telephone: (415) 371-2200  
Facsimile: (415) 371-2201  
**Direct Dial: (415) 371-2267**





RECEIVED BY THE U.S. PATENT AND TRADEMARK OFFICE

Expressed Mailed: September 9, 2003

Express Mail Label No. ER 203738025 US

SENORX, Inc.: EJL/aml

Attorney Docket No.: R0367-01901 EJL/EJL/RD

U.S. Patent Application Entitled: HIGH FREQUENCY POWER SOURCE

Applicant(s): *Dabney et al.*

Application No.: Unassigned

Filed: Herewith

Examiner of Parent Appl.: R. S. Kearney Group Art Unit: 3739

Enclosed: **Request for Filing a Divisional Application Under 37 C.F.R. §1.53(b) Transmittal** (in duplicate), including:  
(Complete application as filed, 36 sheets of formal drawings and a copy of the signed declaration);  
AMENDMENT; and  
Return Receipt Postcard.

Please acknowledge receipt of these documents by stamping and returning this postcard. Thank you - Duane Morris LLP

39451 U.S. PTO

10/658572



09/09/03



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of  
Dabney et al.

For: **HIGH FREQUENCY POWER SOURCE**

Serial No.: 10/658,572

Filed: September 9, 2003

Atty. Docket No.: R0367-01901

) Examiner: Not yet assigned

) Group: 3739

) **RESPONSE TO NOTICE OF**  
) **OMITTED ITEM(S) IN A**  
) **NONPROVISIONAL APPLICATION**

**CERTIFICATE OF MAILING PURSUANT TO 37 CFR 1.8**

I hereby certify that this paper is being deposited in the United States mail as first class mail with postage prepaid, and is addressed to Mail Stop  
Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 1/20/2004 in San Francisco, CA.

By: *RL*

Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notice of Omitted Item(s) In A Nonprovisional Application – Filed  
Under 37 CFR §1.53(b) mailed December 4, 2003, transmitted herewith is Part 2 of the Notice  
and formal drawings of Figures 13, 14 (sheets 35/36 and 36/36) in the above-referenced  
application.

Respectfully submitted,

By: *Edward J. Lynch*  
Edward J. Lynch  
Registration No. 24,422  
Attorney for Applicants

DUANE MORRIS LLP  
One Market  
Spear Tower, Ste. 2000  
San Francisco, CA 94105  
Telephone: (415) 371-2200  
Facsimile: (415) 371-2201  
Direct Dial: (415) 371-2267

35/36

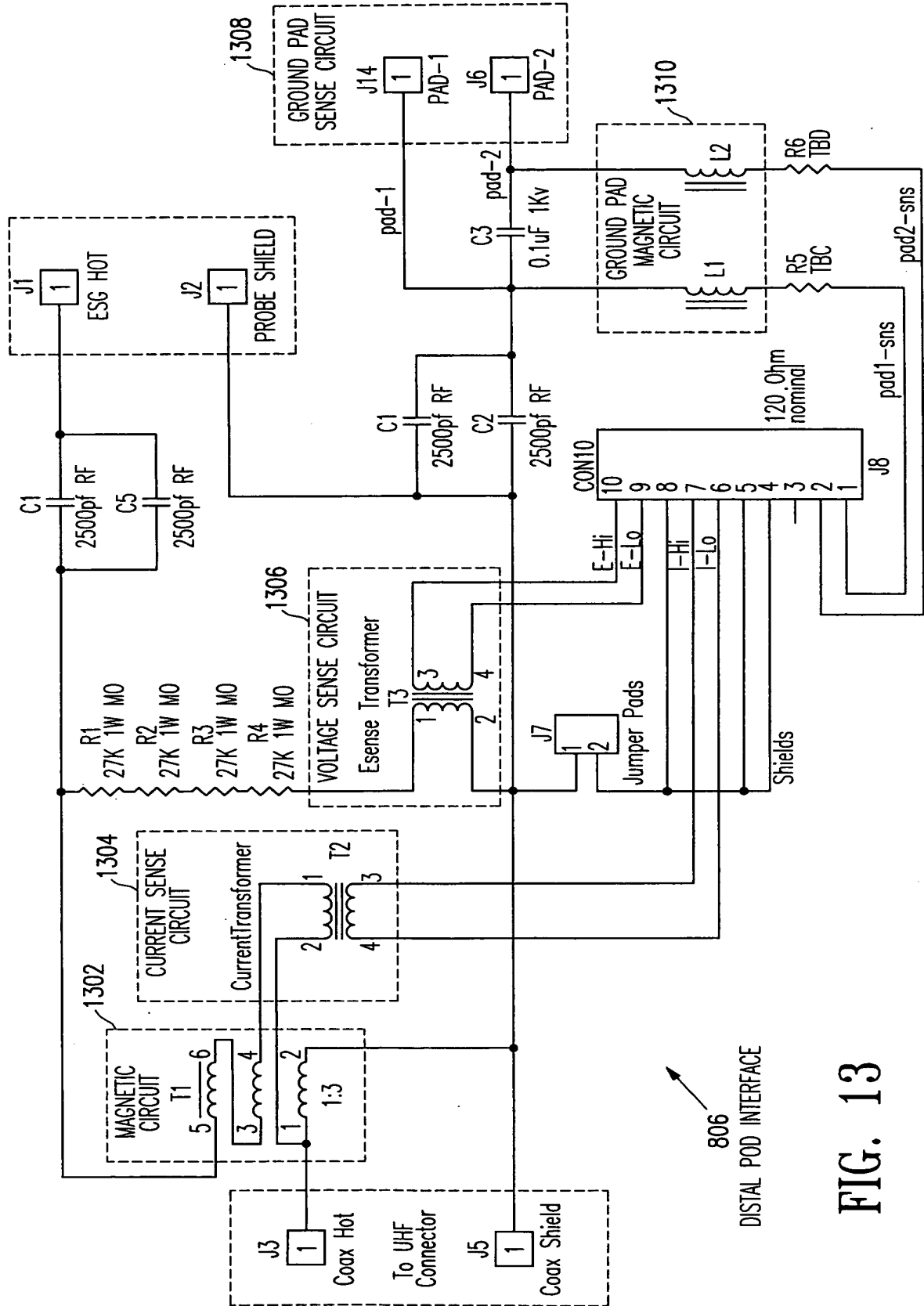
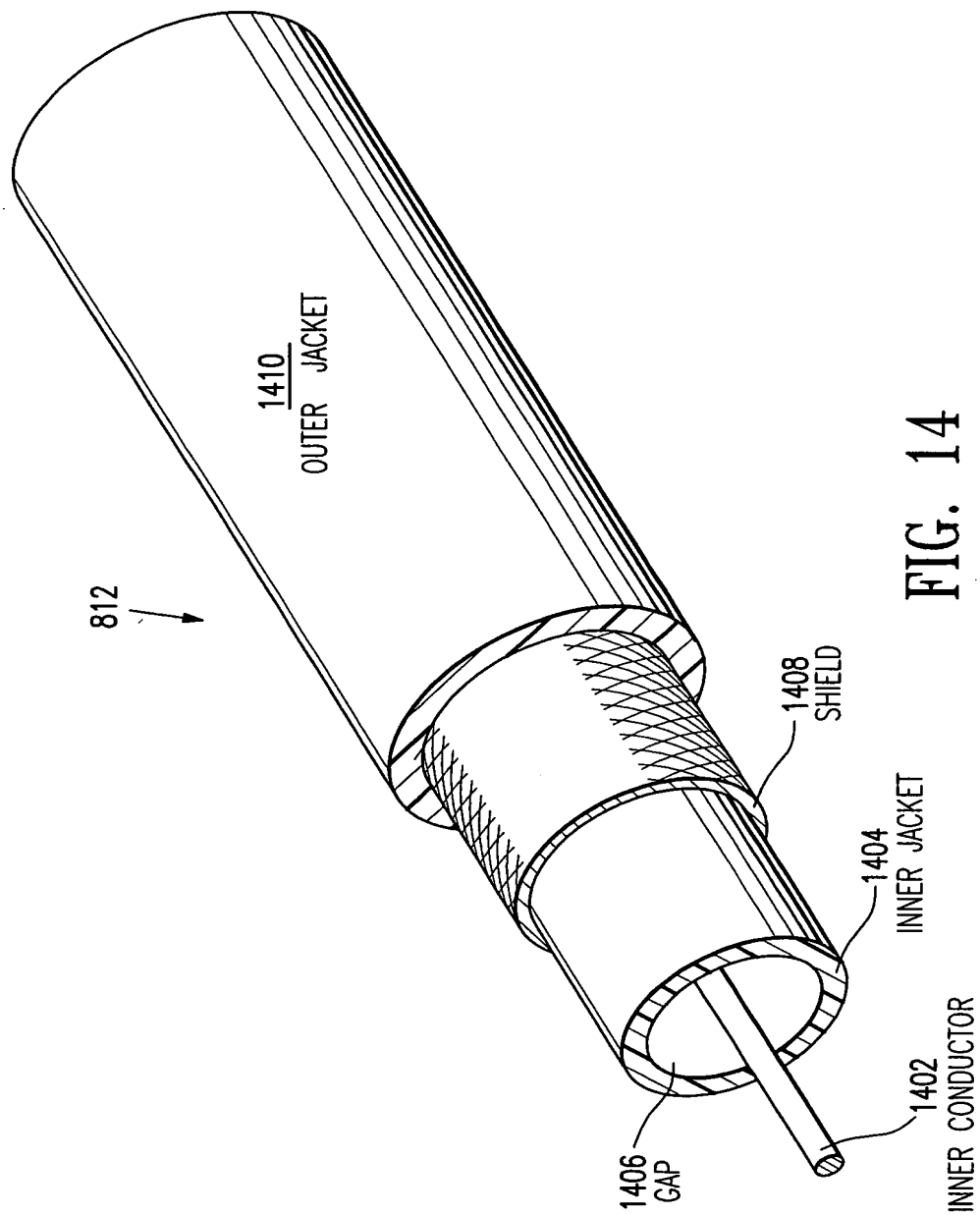


FIG. 13



HIGH FREQUENCY POWER SOURCE  
INVENTORS: BURBANK, ET AL.  
U.S. SERIAL NO. 09/752,978

36/36





## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/658,572	09/09/2003	James Huntington Dabney	R0367-01901

CONFIRMATION NO. 3419

## FORMALITIES LETTER



\*OC000000011411212\*

Edward J. Lynch  
Duane Morris LLP  
One Market  
Spear Tower, Suite 2000  
San Francisco, CA 94105

Date Mailed: 12/04/2003

## NOTICE OF OMITTED ITEM(S) IN A NONPROVISIONAL APPLICATION

## FILED UNDER 37 CFR 1.53(b)

A filing date has been accorded to the above-identified nonprovisional application papers; however, the following item(s) appear to have been omitted from the application:

- Figure(s) 13, 14 described in the specification.

I. Should applicant contend that the above-noted omitted item(s) was in fact deposited in the U.S. Patent and Trademark Office (USPTO) with the nonprovisional application papers, a copy of this Notice and a petition (and \$130.00 petition fee (37 CFR 1.17(h))) with evidence of such deposit **must** be filed within **TWO MONTHS** of the date of this Notice. The petition fee will be refunded if it is determined that the item(s) was received by the USPTO.

II. Should applicant desire to supply the omitted item(s) and accept the date that such omitted item(s) was filed in the USPTO as the filing date of the above-identified application, a copy of this Notice, the omitted item(s) (with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items), and a petition under 37 CFR 1.182 (with the \$130.00 petition fee (37 CFR 1.17(h))) requesting the later filing date **must** be filed within **TWO MONTHS** of the date of this Notice.

Applicant is advised that generally the filing fee required for an application is the filing fee in effect on the filing date accorded the application and that payment of the requisite basic filing fee on a date later than the filing date of the application requires payment of a surcharge (37 CFR 1.16(e)). To avoid processing delays and payment of a surcharge, applicant should submit any balance due for the requisite filing fee based on the later filing date being requested when submitting the omitted items(s) and the petition (and petition fee) requesting the later filing date.

III. The failure to file a petition (and petition fee) under the above options (I) or (II) within **TWO MONTHS** of the date of this Notice (37 CFR 1.181(f)) will be treated as a constructive acceptance by the applicant of the application as deposited in the USPTO. **THIS TWO MONTH PERIOD IS NOT EXTENDABLE UNDER 37 CFR 1.136(a) or (b)**. In the absence of a timely filed petition in reply to this Notice, the application will maintain a filing date as of the date of deposit of the application papers in the USPTO, and original application papers (*i.e.*, the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit.

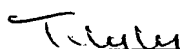
In the event that applicant elects not to take action pursuant to options (I) or (II) above (thereby constructively electing option (III)), amendment of the specification to renumber the pages consecutively and cancel incomplete sentences caused by any omitted page(s), and/or amendment of the specification to cancel all references to any

omitted drawing(s), relabel the drawing figures to be numbered consecutively (if necessary), and correct the references in the specification to the drawing figures to correspond with any relabeled drawing figures, is required. A copy of the drawing figures showing the proposed changes in red ink should accompany with any drawing changes. Such amendment and/or correction to the drawing figures, if necessary, should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

Replies should be mailed to: Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

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*A copy of this notice **MUST** be returned with the reply.*

  
\_\_\_\_\_  
Customer Service Center  
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE



RECEIVED BY THE U.S. PATENT AND TRADEMARK OFFICE

Expressed Mailed: September 9, 2003

Express Mail Label No. ER 203738025 US

SENORX, Inc.: EJI/aml

Attorney Docket No.: R0367-01901 EJI/EJI/RD

U.S. Patent Application Entitled: HIGH FREQUENCY POWER SOURCE

Applicant(s): *Dabney et al.*

Application No.: Unassigned

Filed: Herewith

Examiner of Parent Appl.: R. S. Kearney Group Art Unit: 3739

Enclosed: **Request for Filing a Divisional Application Under 37 C.F.R. §1.53(b) Transmittal** (in duplicate), including:  
(Complete application as filed, 36 sheets of formal drawings and a copy of the signed declaration);  
AMENDMENT; and  
Return Receipt Postcard.

Please acknowledge receipt of these documents by stamping and returning this postcard. Thank you - Duane Morris LLP

39451 U.S. PTO

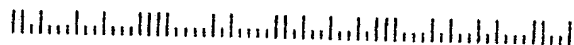
10/658572



09/09/03



**DUANE MORRIS LLP**  
One Market, Spear Tower Suite 2000  
San Francisco, CA 94105-1104





# UNITED STATES PATENT AND TRADEMARK OFFICE

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## Office of the Deputy Commissioner for Patent Examination Policy

International Liaison Staff    MPEP    Office of Petitions    Office of Patent Legal Administration  
 PCT Legal Administration    PCT Legal Affairs    PCT Special Programs    Inventor Assistance Center

[USPTO Home Page](#)

## Office of Petitions

[WIPO Home Page](#)

## INTRODUCTION

[Trilateral Home Page](#)

## Petitions Practice Within the USPTO on Patent Matters

[General References](#)

### I. Introduction

[Manual of Patent Examining Procedure](#)

The information below will hopefully provide patent applicants with some of the basic principles of petitions practice. As with all aspects of patent prosecution, there are laws and regulations that must be followed by employees of the USPTO in the area of petitions. The USPTO recommends that inventors and applicants unfamiliar with the patent laws, rules, and USPTO procedures, consult a registered patent attorney or agent to conduct the prosecution of their patent applications. Although the USPTO may not recommend a particular patent attorney or agent, **a list of patent attorneys and agents** registered to practice before the USPTO can be found by following the link.

[WIPO Standards, Recommendations and Guidelines](#)

[Announcements including pertinent Federal Register Notices](#)

[Official Gazette Notices](#)

[Patent Rules \(37 CFR\)](#)

[Patent Laws \(35 U.S.C.\)](#)

[Current Fee Schedule](#)

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[Related External Internet Sites](#)

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[Searchable United States Code](#)

The links provided in this text will take you to a page on the USPTO website where you can either view or download the cited law, rule, or Manual of Patent Examining Procedure (M.P.E.P.) section. At this time it is not possible to directly link to a specific section of these documents. After you view the citation in which you are interested, hit your BACK button to return to this page. Not all citations of Laws (35 U.S.C.) or Rules (37 C.F.R.) are hyperlinked. Since all such links take you to the same location, just click on any similar linked citation. Links to printable forms (where provided) should take you directly to the form if you have Adobe Acrobat Reader properly loaded. Otherwise you may have to go to the **USPTO homepage** and then click on the printable forms button.

For those patent matters which are not subject to an appeal to the Board of Patent Appeals and Interferences and the federal courts, supervisory and administrative review is conducted, in part, by the rendering of decisions on petitions. The Director of the USPTO (formerly the Commissioner) has delegated to appropriate USPTO officials the authority to decide certain petitions. The various delegations are set forth in chapter 1000 of the MPEP. The more common types of petitions handled in the Office of Petitions are identified below and the requirements which must be met for the granting of a petition are discussed. Where appropriate, links to other information are provided.



## REQUIREMENTS OF A PETITION

In general each petition has five (5) requirements. These requirements are as follows:

<p><b>1. The petition must be in writing, 37 CFR 1.2.</b></p>	<p>All business with the USPTO is transacted in writing. The petition should be directed to the USPTO official delegated the authority to decide that petition. See MPEP Chapter 1000. Since different matters may be considered by different branches or sections of the USPTO, each distinct subject, inquiry or request should be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. 37 CFR 1.4(c).</p>
<p><b>2. The petition must contain a statement of facts involved, the point(s) to be reviewed and the action requested, 37 CFR 1.181(b).</b></p>	<p>The care and completeness with which petitions are drafted can clearly influence the decision rendered. 37 CFR 1.181(b) sets forth the general requirements for the content of a petition. The petition must contain a statement of the facts involved, the point(s) to be reviewed and the action or relief requested. The petition submitted should be as complete as possible and any evidence necessary should be submitted. Any error(s) in a requirement or action on the part of the USPTO should be clearly set forth with the reasons why such requirement or action is considered improper.</p>
<p><b>3. The petition must be accompanied by a fee, if required, in order to avoid the petition being summarily dismissed, 37 CFR 1.181(d).</b></p>	<p>To avoid a petition being summarily dismissed for lack or insufficient fee, petitioner should make certain that the correct petition fee is submitted along with the petition. See the <b>updated fee sheet</b> for guidance.</p>
<p><b>4. The petition must be timely filed, as required in 37 CFR 1.181(f), or as required in a specific statute or regulation.</b></p>	<p>Generally a petition not filed within two (2) months from the action complained of may be dismissed as untimely. Further, the mere filing of a petition will not stay the period for replying to an examiner's action that may be running against an application or act as a stay of other proceedings. 37 CFR 1.181(f).</p>
<p><b>5. The petition</b></p>	<p>Care should be taken to review the applicable</p>

<p><b>must comply with any specific requirements as provided by statute, regulation or USPTO policy.</b></p>	<p>statute, regulation or USPTO policy to determine if there are other requirements that need to be met in submitting the petition.</p>
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## **Specific Types of Petitions Treated in the Office of Petitions**

### **A. Petitions to Permit Filing a Patent Application When An Inventor Refuses or Cannot Be Reached to sign the Oath or Declaration See MPEP 409.03**

Where a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, a petition under **37 CFR 1.47(a)** may be filed to permit acceptance of an application filed by the other inventor(s) on his or her behalf and that of the non-signing inventor. The submission must set forth the diligent efforts made to contact the non-signing inventor, the required fee and the last known address of the non-signing inventor.

Similarly, whenever all of the inventors or the sole inventor refuse(s) to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventors have assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may file an application for patent on behalf of the non-signing inventor(s). A petition to permit filing under **37 CFR 1.47(b)** must be submitted with the oath or declaration executed by the Rule 47 applicant on behalf of the non-signing inventor(s).

Either of the above petitions must include:

1. Proof that the non-signing inventors were presented with the application papers and refused to sign the oath or declaration or that the non-signing inventor(s) could not be found or reached after diligent effort;
2. The required fee; and
3. The last known address of the non-signing inventor(s).

Additionally, when filing under **37 CFR 1.47(b)** petitioner must provide proof of proprietary interest and state that the filing of the application for patent is necessary to preserve the rights of the parties or to prevent irreparable damage. Proof of proprietary interest may be provided with a copy of an assignment, a written agreement to assign or a memorandum of law establishing that a court of competent jurisdiction would award title of the invention to the Rule 47 applicant.

In a continuation or divisional application, a copy of an oath or declaration from a prior application may be filed. If a petition under 37 CFR 1.47 was granted in the prior application and the non-signing inventor(s) did not later join in the application, a copy of the decision granting status under 37 CFR 1.47 in the prior application must also be filed.

## **B. Petitions to Obtain or Correct a Filing Date**      See MPEP 600

37 CFR 1.53 provides procedures for filing patent applications. All applications filed under 37 CFR 1.53(b) require a specification, including at least one claim, drawings, if necessary to understand the claimed subject matter, an oath or declaration, and the required filing fee. Before an application is examined to determine patentability, the application, by law, must be complete so as to receive an official filing date. If the application is complete, the applicant will receive a filing date receipt. Failure to file a complete application will result in the USPTO forwarding a communication to the applicant noting that errors/problems exist in the application filing which require correction.

When filing an application for patent, applicant is encouraged to submit a self addressed postcard with the application papers. See MPEP 503. The postcard should indicate what is being submitted to the USPTO. For example only, the postcard should state "transmitted herewith is an application for patent for John J. Johns, including 5 pages of specification, 6 claims, 4 sheets of drawings having 9 figures therein, a signed declaration, and a check in the amount of \$\_\_\_\_\_ for the statutory filing fee." (Be sure to check the latest **fee sheet** for the correct amount of fees to submit.) The postcard will be date stamped by the USPTO mailroom and will serve as proof of what was submitted by applicant. It is important that the postcard itemize all of the components of an application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the USPTO.

Once the official filing receipt for the patent application is received, a review of the filing receipt should be made to ascertain whether the filing date and other application data are correct. If the information there on is incorrect, applicant should promptly contact the USPTO. Keep in mind that the filing date receipt is not an indication that a patent will issue. It merely signifies that a complete application has been filed and that the application will be forwarded to a patent examiner for examination purposes.

To provide applicants with a more detailed recitation of the typical types of errors committed in filing applications and how to rectify such errors, the following topics and discussion relating thereto is provided.

### **1. Common Errors When Filing Applications**

The application is not accompanied by a return postcard listing the parts of the application in sufficient detail to serve as evidence of the exact papers which were filed.

The application is not accompanied by the correct filing fee or the appropriate declaration for application (see for example, <http://www.uspto.gov/web/forms/sb0001.pdf>).

The applicant wants the date the application was mailed to the USPTO as the application filing date, but fails to use the "Express Mail Post Office to Addressee" service of the U.S. Postal Service to deliver the application. Only the "Express Mail Post Office to Addressee" service of the US Postal Service can be used to obtain the date of mailing as an application filing date.

The applicant fails to retain a complete copy of the application.

The nonprovisional application is filed without a claim.

The copy of the application forwarded to the USPTO is missing one or more pages of the specification or drawings.

The application is filed without a correspondence address.

## **2. Things to Remember**

The patent application process is complex. The USPTO cannot assist in the preparation of application papers. If you are ready to apply for a patent, we strongly advise you to contact a registered patent attorney or agent to assist you.

There are several types of patent application, for example, utility, design, provisional, nonprovisional, each of which requires different filing fee and has a different legal effect.

The application must be accompanied by a request not to publish the application, if pre-patent grant publication is not desired.

## **3. Remedy to Correct Errors**

The usual remedy to correct a 37 CFR 1.53 filing error is to file a petition directed to the Office of Petitions explaining the delay in submitting the omitted item. Any missing items should accompany the petition and should be accompanied by the fee required by 37 CFR 1.17 (h).

Remember, compendancy cannot be waived as it is a statutory

requirement. Therefore, applicant must petition to revive the parent application under 37 CFR 1.137 to obtain copendency if the parent application became abandoned prior to filing of the continuing application.

#### **4a. Express Mail Errors**

Typical Errors committed by applicants who use the provisions of 37 CFR 1.10 ("Express Mail" procedures) are described below.

- A. Problems arise when correspondence is deposited in an Express Mail drop box late in the day after the last pick-up has occurred. The "Date-In" on the label is the date the Post Office receives the correspondence. Applicants should deposit the correspondence directly with an employee of the US Postal Service at the Post Office window when possible and get a legible copy of the "Express Mail" mailing label with the "Date-In" clearly marked. Applicants should then check the "Date-In" on the receipt. The "Date-In" must be entered by the Post Office, not applicant (See MPEP 513);
- B. Applicants file separate papers or different applications in the same mailing envelope which do not each have the Express Mail number thereon;
- C. The proper postage has not been provided.
- D. The Express Mail label is not properly addressed.

#### **4b. Remedy to Correct Errors**

A. Express Mail correspondence received in the USPTO, but given a date other than "date-in" on the receipt.

In accordance with 37 CFR 1.10(c), one may file a petition to have an earlier filing date accorded, provided that:

- (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
- (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and
- (3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of

deposit.

**B. Express Mail correspondence given incorrect date or no date by the USPS.**

In accordance with 37 CFR 1.10(d), one may file a petition to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

**C. Express Mail correspondence not received in the USPTO.**

In accordance with 37 CFR 1.10(e), one may file a petition to have such correspondence considered as having been filed in the USPTO on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;"

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt; a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph B(3), above, that the requested filing date was the date the correspondence was

deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence, and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence and original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

**5a. Missing Drawing(s)/Figure(s) or Omitted Specification Page(s)**

(1) A drawing is required for a filing date where it is necessary for the understanding of the subject matter sought to be patented ( 35 U.S.C. 111 and 113, 1st sentence), or if described in the specification (MPEP, 506, 601.01 and 608.02);

(2) Check the application before filing to ensure that any drawing referred to in the specification is present;

(3) Check the drawings to ensure that each figure is properly labeled;

(4) Number each page of the specification in consecutive order and review the application for completeness before filing;

(5) A postcard receipt should contain a specific itemization of all the items being submitted (MPEP 503). Therefore, the post card receipt should specifically itemize the number of pages of the specification, the number of pages of the declaration and the number of sheets of drawings (including the number of figures contained thereon) being submitted. (Note: hundreds of postcard receipts each year are never returned to counsel because correct postage or return address is lacking);

(6) The best evidence of what the Office received is a properly itemized postcard receipt stamped with the mail room date.

**5b. Remedy to Correct Errors**

If an application is filed without all the pages of the specification or without all of the figures of the drawings, the Office will still accord a filing date to any application that contains something

that can be construed as a written description, any necessary drawing, and, in a nonprovisional application, at least one claim. The Office will mail a notice to applicant indicating that the application has been accorded a filing date, but is missing pages of the specification or figures of drawings. The mailing of the notice will permit applicant to either: (1) promptly establish prior receipt in the USPTO the pages at issue (generally by way of a date-stamped postcard receipt); or (2) promptly submit the omitted page(s) and accept the date of submission as the application filing date. See MPEP 601.01 (d).

An applicant asserting that the page(s) was in fact deposited in the Office with the application papers must promptly file a petition under 37 CFR 1.53(e) (and the petition fee under 37 CFR 1.17(h) which will be refunded if it is determined that the page(s) was in fact received by the USPTO) with evidence of such deposit.

Applicants desiring to submit the omitted page(s) and accept the date of submission as the application filing date must promptly submit the omitted pages or drawings and include an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such page(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date.

Failure to promptly (within an extendable two month period) file a petition under 37 CFR 1.53 (e) or 1.182 in response to such notice will result in the Office treating the application as including only those papers originally deposited. Amendment of the specification is required in a nonprovisional application to renumber the pages consecutively and to cancel any incomplete sentences.

Petitions to obtain or correct a filing date should be directed to the attention of the Office of Petitions and must include the petition fee or an authorization to charge the petition fee to a deposit account. If the petition alleges that no defect exists, a request for refund of the petition fee maybe included in the petition.

### **C. Petitions Relating to Abandoned Applications or Lapsed Patents** See MPEP 711.03 (c)

#### **1. Revival**



37 CFR 1.137 covers petitions to revive applications abandoned for failure to prosecute, or failure to pay the required issue fee and petitions to revive a lapsed patent for failure to pay any balance of the issue fee due. There are two kinds of petitions to revive identified in this regulation. 37 CFR 1.137(a) addresses revival based upon an unavoidable delay in prosecution or payment of the required issue fee, whereas 37 CFR 1.137(b) addresses revival based upon an unintentional delay in prosecution or payment of the required issue fee.

**(a) Requirements for a petition under 37 CFR 1.137(a) (delay was unavoidable):**      **[click here to obtain form](#)**

- (1) Required reply, unless previously filed.
- (2) Petition fee set forth in 37 CFR 1.17(l).
- (3) Showing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.
- (4) Any terminal disclaimer under 37 CFR 1.321 (with fee; 37 CFR 1.20(d)) dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application if the application is a design application (regardless of filing date) or a utility application filed before June 8, 1995, or a plant patent application filed before June 8, 1995. The terminal disclaimer provisions of this paragraph do not apply to lapsed patents.

**(b) Requirements for a petition under 37 CFR 1.137(b) (delay was unintentional):**      **[click here to obtain form](#)**

- (1) Required reply, unless previously filed.
- (2) Petition fee set forth in 37 CFR 1.17(m).
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. No showing of reasons for delay is necessary. However, the Commissioner may require additional information where there is a question whether the delay was unintentional.
- (4) Any terminal disclaimer under 37 CFR 1.321 (with fee; 37 CFR 1.20(d)) dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application if the application is a design application (regardless of filing date) or a utility application filed before June 8, 1995 or a plant patent application filed before June 8, 1995. The terminal

disclaimer provisions of this paragraph do not apply to lapsed patents.

#### Typical Problems Found in 37 CFR 1.137 Petitions

- (1) Statements are filed by a petitioner who was not the party responsible for prosecuting the application at the time of the abandonment. Therefore, the petitioner is not in a position to know whether the delay was unavoidable or unintentional.
- (2) The petitioner attributes fault for the delay in filing a reply to an employee such as a secretary, clerk or courier without submitting a statement from that person.
- (3) Petitions are not signed prior to being sent by facsimile transmission or other delivery means to the Office.
- (4) Petitioner intentionally delays the filing of a petition after first becoming aware of the abandonment. While questions are not normally raised when petitions under the unintentional standard are filed within one year of the date of abandonment, it is not appropriate to intentionally delay the filing of a petition after becoming aware of the abandoned status of the application.
- (5) Petitioner does not submit a proper reply to an outstanding office action with the petition. By way of example, amendments filed after a final rejection, do not constitute a proper reply if the examiner refuses to have the amendment entered due to non-compliance with 37 CFR 1.116. Unless an amendment filed after a final rejection clearly places the application in condition for allowance, it is recommended that the reply filed be a Notice of Appeal, a CPA, or RCE.
- (6) Petitioners mistakenly believe that lack of knowledge of the rules or reliance on oral statements by Office employees are acceptable reasons for a petition under the unavoidable standard to be granted.
- (7) Some petitioners attempt to revive a provisional application beyond twelve months from filing. While the petition can be filed outside the twelve-month period (usually for copendency), a provisional application can only be pending for a period of twelve months from filing.

#### THINGS TO REMEMBER

- (1) Petitions to revive filed under either the unavoidable or the unintentional standards should be filed within two months of becoming aware of the abandonment of the application to avoid any question of timeliness.

(2) Renewed petitions to revive must be filed within two months of an adverse decision on the earlier petition to revive to be considered timely, unless a proper extension of time up to an additional five months (for a total of seven months) is obtained under 37 CFR 1.136(a). Otherwise, the Office may require a specific showing as to how the entire delay was unavoidable or unintentional.

(3) A petition under 37 CFR 1.137(a) must be accompanied by the petition fee set forth in 37 CFR 1.17(l) and a petition under 37 CFR 1.137 (b) must be accompanied by the petition fee set forth in 37 CFR 1.17(m). The petition fee is required by statute. See 35 U.S.C. 41(a) (7). Thus, the Office cannot grant requests for waiver or reduction of the requisite petition fee.

(4) In a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application .

(5) In an application abandoned for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof even if the application is to then be abandoned in favor of a continuing application. In a patent lapsed for failure to pay the balance of issue fee due, the required reply is payment of the balance of issue fee due.

(6) In a provisional application abandoned for failure to timely comply with an Office requirement, the reply requirement must be met by a complete reply to such Office requirement.

(7) 37 CFR 1.137(b) is applicable to applications abandoned and patents lapsed, regardless of the length of time that the application was abandoned or the patent was lapsed. However, note that 37 CFR 1.137(b) requires that the entire period of delay, from the due date of the reply to the date of filing a grantable petition to revive, was unintentional for a petition under 37 CFR 1.137(b) to be granted.

(8) While a statement of unintentional delay for the entire period of abandonment is generally sufficient, 37 CFR 1.137 (b) authorizes the Office to require additional information when there is a question whether the entire delay was unintentional. In such instances, the Office may require evidence for each of the three critical periods: (1) the delay in filing a timely reply before abandonment of the application or lapse of the patent; (2) the delay in filing an initial petition to revive; and (3) the delay in filing a grantable petition to revive.

(9) An applicant who deliberately delays the filing of a petition under 37 CFR 1.137 will not be able to show that

"the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional".

(10) Examples of situations where unintentional delay was argued but the Office held these activities to constitute intentional delay:

(A) where the applicant deliberately permits an application to become abandoned (i.e., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that an invention lacks sufficient commercial value to justify continued prosecution);

(B) where the applicant chooses not to seek or persist in seeking revival of an abandoned application, or where the applicant deliberately chooses to delay seeking revival of an abandoned application;

(11) An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (a) the correctness of the applicant (or applicant's representative) decision to abandon the application or not to seek or persist in seeking revival of the application; (b) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (c) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

(12) An intentional abandonment of an application, or an intentional delay in seeking either the withdrawal of a holding of abandonment in, or the revival of, an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137.

(13) Where an applicant chooses not to seek revival of an application, or chooses not to persist in seeking revival after an adverse decision on an earlier petition, the resulting delay cannot be considered to be unavoidable or unintentional.

(14) A provisional application can be revived for a period not to exceed 12 months from the date of filing, even if the petition is filed outside this 12 month period.

#### **D. Relating to Maintenance Fees**

Maintenance fees may be paid during the 6 month period following the 3rd, 7th, and 11th anniversary of issuance of a utility patent. If not timely paid, a surcharge will be required between 3 ½ and 4 years, 7 ½ and 8 years, and 11 ½ and 12 years after issuance of the patent. Utility patents will expire after 4 years, 8 years and 12 years from issuance if the maintenance fee and surcharge, if required, are not timely paid. The due date for payment of maintenance fees in reissue applications is computed from the date of grant of the original non reissue application. See MPEP Chapter 2500.

#### **1. Payment Prior to Expiration** See MPEP 2580.

A patentee who is not satisfied with the USPTO refusal to accept and record a maintenance fee paid prior to expiration of a patent may petition under 37 CFR 1.377. The requirements for acceptance of the payment are:

- (1) Petition under 37 CFR 1.377;
- (2) Filing within 2 months of action complained of or within the time set in the action complained of;
- (3) Petition fee; 37 CFR 1.17(h). The petition may include a request for refund of the petition fee if the refusal to accept and record the maintenance fee is determined to be Office error;
- (4) Statement of facts as outlined at 37 CFR 1.181(b);
- (5) Signature by registered attorney or party in interest as outlined at 37 CFR 1.377(c);

#### **2. Payment After Expiration** See MPEP 2590

- (a) Requirements when the delay was unavoidable. [click here to obtain form](#)

Payment of maintenance fees after expiration of the patent will be accepted and the patent will be reinstated as if it had never expired, provided the following are filed:

- (1) Petition under 37 CFR 1.378(b) signed by registered attorney or party in interest as outlined at 37 CFR 1.378(d).
- (2) Maintenance fee set forth in 37 CFR 1.20 (e)-(g).

(3) Surcharge set forth in 37 CFR 1.20(i)(1).

(4) Showing of unavoidable delay including an enumeration of steps taken to ensure timely payment, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

(b) Requirements when the delay was unintentional.  
**Click here to obtain form here**

Payment of maintenance fees after expiration of the patent will be accepted and the patent will be reinstated as if it had never expired, provided the following are filed:

(1) Petition under 37 CFR 1.378(c) filed within 24 months after the six-month grace period signed by registered attorney or party in interest as outlined at 37 CFR 1.378(d).

(2) Maintenance fee set forth in 37 CFR 1.20 (e)-(g).

(3) Surcharge set forth in 37 CFR 1.20(i)(2).

(4) A statement that the delay in payment of the maintenance fee was unintentional.

### **3. Reconsideration**

**A first request for reconsideration will be entertained provided the following are filed within two months, or such other time as set in an adverse decision on a petition filed under 2(a) or 2(b) above:**

(1) Petition under 37 CFR 1.378(e).

(2) Petition fee set forth in 37 CFR 1.17(h).

(3) All pertinent evidence or arguments presented since no further request for reconsideration will be entertained.

A common error made in the filing of a maintenance fee petition is the lack of proper identification (by both the patent number and the application number) of the patent as required by § 1.366(c).

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